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EXAMINER

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte JONATHAN DUNNE and JEFFREY B. SLOYER

Appeal 2015-007281
Application 13/893,650
Technology Center 2100

Before CARLA M. KRIVAK, IRVIN E. BRANCH, and JOHN R. KENNY,
Administrative Patent Judges.

Opinion for the Board filed by *Administrative Patent Judge* IRVIN E.
BRANCH.

Opinion Dissenting filed by *Administrative Patent Judge* JOHN R. KENNY.
BRANCH, *Administrative Patent Judge.*

DECISION ON REQUEST FOR REHEARING

STATEMENT OF THE CASE

Appellants request rehearing of our Decision on Appeal entered January 27, 2017 (“Decision”), in which we affirmed the Examiner’s rejection of claims 25–33.

ANALYSIS

We have reviewed the Request for Rehearing (“Req. Reh’g”) in view of our Decision. Appellants’ arguments do not persuade us of anything our decision misapprehended or overlooked. We note the following for emphasis.

Claims 27, 29, and 30

Appellants “assume” we overlooked Appellants’ arguments (App. Br. 15–17; Reply Br. 8–10) as to claims 27, 28, and 30 based on the premise we did not “summarize Appellants’ arguments” and we did not “explain why [we] accepted the Examiner’s arguments.” Req. Reh’g 3–4.

To clarify, our Decision states we “adopt as our own the findings and conclusions set forth by the Examiner in the Final Action and the Examiner’s Answer” (Decision 2–3) and find Appellants’ arguments “unpersuasive for the reasons stated by the Examiner (Final Act. 6–7; Ans. 11).” *Id.* 4 (citing Appellants’ arguments “App. Br. 15–17; Reply Br. 8–10”). That adopted material is to be treated as if it is part of our Decision. *See In re Icon Health and Fitness, Inc. v. Strava, Inc.*, 849 F.3d 1034, 1043 (“the PTAB [is] authorized to adopt the Examiner’s findings”).

The record established by the Examiner (Final Act. 6–7; Ans. 11) adequately explains the basis of the rejection and the lack of persuasiveness in Appellants’ arguments (App. Br. 15–17; Reply Br. 8–10). Accordingly, Appellants’ arguments (Req. Reh’g 3–4) do not persuade us of anything we misapprehended or overlooked.

Claim 25

Appellants contend (Req. Reh’g 4–8) we misapprehended or overlooked certain of Appellants’ claim 25 arguments (App. Br. 8–10; Reply Br. 2–3) because we did not summarize Appellants’ arguments or explain

why the Examiner's arguments are persuasive. Appellants also repeat previously-presented arguments, alleging error in the majority's conclusion. *See, e.g.*, Req. Reh'g 8 ("the dissent accurately recognizes the problem with the analysis presented by the majority" and "[t]he dissent's second point correctly identifies the error in the majority's new finding that 'calculated average ('average response time,' ¶ 16) also describes claim 25's calculated forecast'"). Appellants also argue our Decision includes an undesignated new ground of rejection. *Id.* FN 3.

Regarding claim 25's "determining a transaction time for each of a plurality of transactions to a system under test during a reliability test, wherein the plurality of transactions are of a same transaction type," Appellants' contend

Referring to the underlined portion of the above-reproduced passage ["Appellants' arguments overlook the Examiner's findings with respect to Fraenkel, Fig. 13"], the Board's only substantive response to Appellants' arguments was that "Appellants' arguments overlook the Examiner's findings with respect to Fraenkel." Like the aforementioned dependent claims, the Board's analysis does not meet the requirements of Nuvasive. Merely asserting that Appellants have overlooked certain findings by Nuvasive [sic the Examiner] is no more than a summarization of the Examiner's finding that fails to explain why the Board accepted the Examiner's arguments. Without recognizing Appellants' arguments or explaining why these arguments were unpersuasive, Appellants can only assume that the Board overlooked Appellants' arguments.

Req. Reh'g 4–5 (quoting Decision 3). Our Decision, however, did not "[m]erely assert[] that Appellants have overlooked certain findings by Nuvasive [sic the Examiner]" (*id.*), our Decision also quoted the Examiner's un rebutted finding (Decision 3 (quoting Ans. 8 ("in figure 13 and other locations, the figure shows multiple graphs, each is an average of a type; for

example, ‘update account’ is a type, and since each point in the graph is an average, it is an average of multiple values of a same type”))).

Because Appellants’ Reply Brief arguments (Reply Br. 2–3) did not mention or persuasively rebut the Examiner (i.e., “Appellants’ arguments overlook[ed] the Examiner’s findings”), we “disagree[d] with Appellants that the Examiner erred” (Decision 2–3). Accordingly, Appellants’ arguments in the Request for Rehearing do not persuade us of anything our decision misapprehended or overlooked.

Further regarding “determining a transaction time for each of a plurality of transactions to a system under test during a reliability test, wherein the plurality of transactions are of a same transaction type,” Appellants contend “[t]he Board’s citation to ‘Fig. 13. Ans. 8’ only addresses the second of the two issues raised by Appellants. Accordingly, Appellants respectfully submit that the Board has overlooked the first issue raised by Appellants.” Req. Reh’g 4–5.

We understand “first issue” to refer to Appellants’ arguments regarding “transaction time.” *See* App. Br. 8–10 (“The first issue raised by Appellants involved the Examiner’s cited passages failing to teach the claimed ‘transaction time.’ ... Appellants need to have a clear statement, in the written record, as to what teachings are being relied upon by the Examiner as to these limitations.”) Appellants raised the “first issue” in response to the Examiner’s finding “[r]esponse times and network times of interactions performed by a transactional server is a reasonable interpretation of transaction time, without further explanations.” Final Act. 4. Appellants accurately reproduced this finding in the Appeal Brief. *See* App. Br. 9–10. Accordingly, Appellants’ “first issue” amounted to needing “a clear

statement, in the written record, as to what teachings are being relied upon by the Examiner” as to “transaction time.”

The Examiner responded. *See* Ans. 6–8. In particular, the Examiner responded as follows:

Applicants’ arguments are not persuasive because as noted in the office actions, response time and network times of interactions performed by a transactional server is viewed as said claimed “transaction time”. The abstract and other locations pointed to by examiner teach that. In addition, Fraenkel mentions the term “transaction time” in [0106], [0119], [0159], and [0239], however other terms in other locations in Fraenkel, especially the ones pointed to by the examiner, could be reasonably interpreted as the claimed transaction times. The term “transaction time[”] is broad.

Id. 8. In short, the Examiner responded to Appellants’ “need to have a clear statement, in the written record, as to what teachings are being relied upon by the Examiner as to these limitations,” which was the “first issue.”

To whatever extent the “first issue” was more than a lack of citation, Appellants did not persuasively rebut the Examiner’s Answer. *See* Reply Br. 2–3. In particular, Appellants dismissed “[t]he Examiner’s remaining analysis on pages 7 and 8” because it “appear[s] to reproduce the Examiner’s previously-presented arguments.” *Id.* 3 (referring to Ans. 7–8). Appellants specifically responded only to portions of the Examiner’s Answer, namely two paragraphs on page 6 of the Examiner’s Answer, and did not identify where the passage on page 8 that we quote above had been “previously-presented” (*see, generally, id.* 2–3). Accordingly, we “disagree[d] with Appellants that the Examiner erred” and we “adopt[ed] as

our own the findings and conclusions set forth by the Examiner in the Final Action and the Examiner's Answer.” Decision 2–3.¹

Regarding “calculating a forecast of transaction times for the transaction type [and] comparing the forecast with a threshold time using a processor,” our Decision found Appellants’ arguments (App. Br. 10–13; Reply Br. 3–6) unpersuasive and provided an explanation. Decision 3. Accordingly, we are not persuaded that our Decision misapprehended or overlooked Appellants’ arguments as Appellants now contend. Req. Reh’g 5–8.

Specifically, we agreed with the Examiner’s finding that Fraenkel’s average response time being compared to a threshold describes the argued limitations. Decision 3 (citing Fraenkel ¶ 16). This finding appeared in the Final Office Action (Final Act. 6), which we cited in our Decision (Decision 2, “REJECTION”) and which we adopted (*id.* 2–3 (“[w]e ... adopt as our

¹ We did not reach Appellants’ belatedly presented, conclusory argument that “[t]he Examiner’s proposed claim construction is a conclusory assertion that is unsupported by evidence or analysis.” Reply Br. 3 (referring to Ans. 6 (“Applicants’ arguments are not persuasive because the term ‘transaction time’ is broad enough to correspond to the response times and network times performed by transactional servers.”)). “[I]t is inappropriate for appellants to discuss in their reply brief matters not raised in . . . the principal brief[]. Reply briefs are to be used to reply to matter[s] raised in the brief of the appellee.” *Kaufman Company, Inc. v. Lantech, Inc.*, 807 F.2d 970, 973 n.* (Fed. Cir. 1986). The Examiner had made essentially the same finding in the Final Office Action (Final Act. 4) and Appellants’ Appeal Brief repeated the finding but did not timely raise claim construction of “transaction time” on Appeal (*see, generally*, App. Br. 9–10). We review the appealed rejections for error based upon the issues identified by Appellants, and in light of the arguments and evidence produced thereon. Cf. *Ex Parte Frye*, 94 USPQ2d 1072, 1075 (BPAI 2010) (citing *In re Oetiker*, 977 F.2d 1443, 1445).

own the findings and conclusions set forth by the Examiner in the Final Action and the Examiner's Answer)).

The Examiner found Fraenkel describes “**calculating a forecast of transaction times for the transaction type**” and “**comparing the forecast with a threshold time using a processor.**” Final Act. 6 (citing Fraenkel Abstract, ¶¶ 16, 21, and “other location”). Specifically, the Examiner found “average times are calculated and compared to expected ones.” *Id.* (“**calculating a forecast of transaction times for the transaction type** (see [0016], [0021], and other locations: average times are calculated and compared to expected ones (which are also calculated/estimated; view an expected average as said forecast because this is how the system is expected/forecasted to behave)”)”; Ans. 3–4. Fraenkel also discloses “a system administrator responsible for an Atlanta branch office may request to be notified when a particular problem (e.g., average response time exceeds a particular threshold) is detected by computers in that office.” Fraenkel ¶ 16.

For the reasons stated in our Decision (Decision 3) and the additional emphasis we provide *infra*, the Examiner's finding Fraenkel describes “average times are calculated and compared to expected ones” (Final Act. 6; Ans. 3) is sufficient evidence, in the majority's view, that Fraenkel describes “calculating a forecast of transaction times for the transaction type” and “comparing the forecast with a threshold time using a processor,” as recited in claim 25.² As we stated in our Decision, the Examiner's additional finding

² We note Appellants' contention that “it ‘does not make sense’ to perform such a comparison when the elements being compared are necessarily the same.” Req. Reh'g 8 (quoting Dissenting Decision 1). Indeed, we note the Examiner's statement that “the threshold is the forecast as explained above.” Ans. 10. As we explained in the majority Decision and repeat here,

that “Fraenkel’s threshold is a calculated ‘forecast’ of when action should be taken” (Decision 3) does not negate the sufficiency of the Examiner’s principal finding that Fraenkel describes **“calculating a forecast of transaction times for the transaction type”** and **“comparing the forecast with a threshold time using a processor.”** Final Act. 6.

In view of the Examiner’s finding that Fraenkel describes “average times are calculated and compared to expected ones” (Final Act. 6 (citing Fraenkel Abstract, ¶¶ 16, 21, “and other locations”) and Ans. 3) and our adoption of the Examiner’s rejection (Decision 2–3 (“We ... adopt as our own the findings and conclusions set forth by the Examiner in the Final Action and the Examiner’s Answer”)), Appellants’ statements that “Appellants are unable to identify where the Examiner made such a finding” (Req. Reh’g 6) does not persuade us that our Decision misapprehended or overlooked any of Appellants’ arguments. Similarly, neither does Appellants’ contention that “the Board did not cite to either the appealed Office Action [or] the Examiner’s Answer regarding this assertion.” Req. Reh’g 6, FN2. We cited to the Final Action and referred to both. Our adoption of the Examiner’s finding is not, therefore, a new ground of rejection.

Finally, we note Appellants’ contentions regarding “average response time” not being a “forecast.” Req. Reh’g 7 (“paragraph [0016] implies that the ‘average response time’ reflects an average of past response times that are used to detect a current problem”) and 8 (“[t]here is a difference between actual time measurements (e.g., the ‘average response time’ in paragraph [0016]) and a forecast,” “nothing within paragraph [0016] (or the remainder

however, the Examiner’s additional findings are not relevant to our Decision.

of Fraenkel) either explicitly teaches or implies that the ‘average response time,’ at the time it is calculated, refers to future (i.e., forecasted) response times,” and “‘average response time’ refers to response times that have already occurred (i.e., in the past)”). Our dissenting colleague makes a similar argument. Decision Dissenting 1 (“The Specification, however, distinguishes actual time measurements from forecasts. (Spec. Fig. 4, ¶¶ 40–43.)”).

Both Appellants and our dissenting colleague overlook that Fraenkel’s “average” response time is a derivative of actual measurements (i.e., response times). Fraenkel ¶ 16. “Average response time” is not, itself, a measurement. Appellants’ and our dissenting colleague’s arguments do not persuasively explain how Fraenkel’s “average response time” precludes its use as a forecast — i.e., to “predict” or “forecast” a problem. To the contrary, notifying a system administrator when average response time exceeds a particular threshold implies an *ensuing* (i.e., future) problem. In order for an average to exceed a threshold, actual measurements *necessarily* have exceeded the threshold without necessarily triggering the problem that is *forecast* to happen by virtue of the *average* exceeding the threshold.

Moreover, carving “average response time” out of the realm of “forecast” is not supported by Appellants’ Specification. Although the majority did not rely on this in rendering our Decision, we note Appellants intend “forecast” to be interpreted broadly. Spec. ¶ 51 (discussing forecasts: “any of a variety of different models or modeling techniques can be used including various derivatives of the varieties specifically noted herein as appreciated by one skilled in the art. As such, the embodiments disclosed within this specification are not intended to be limited by the various exemplary techniques provided” (emphases added)). As we explain above,

Fraenkel clearly uses “average response time” exceeding a threshold to “forecast” an ensuing problem as Appellants intend “forecast” to be construed (Spec. ¶ 51 (“as appreciated by one skilled in the art”)). Accordingly, we do not agree with our dissenting colleague (Decision Dissenting 1) that Appellants “distinguish” “average response time” from forecast.

Because we relied on, adopted, and expressly discussed (Decision 2–3) the Examiner’s finding that Fraenkel describes “average times are calculated and compared to expected ones” (Final Act. 6 (citing Fraenkel Abstract, ¶¶ 16, 21, “and other locations”)), Appellants’ arguments (Req. Reh’g 5–8) do not persuade us of anything our Decision misapprehended or overlooked with respect to claim 25.

DECISION

Based on the record before us now and in the original appeal, we have granted Appellants’ request to the extent that we have reconsidered our Decision, but we deny Appellants’ request to make any changes in our Decision.

The request for rehearing is denied.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

REHEARING DENIED

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Before CARLA M. KRIVAK, IRVIN E. BRANCH, and JOHN R. KENNY,
Administrative Patent Judges.

KENNY, *Administrative Patent Judge*, dissenting.

Respectfully, I reviewed the majority's analysis in this Decision on Request for Rehearing, but I still would find that Fraenkel's average response time is not the forecast recited by claim 25. Therefore, I respectfully maintain the dissent set forth in the Decision on Appeal, entered January 27, 2017.